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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,174	06/04/2001	Jiro Kajiwara	A-70092/RMA	7640

7590 08/12/2004

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EXAMINER
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MORGAN, EILEEN P

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/874,174

**Applicant(s)**

KAJIWARA ET AL.

**Examiner**

Eileen P Morgan

**Art Unit**

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-20 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-20,25-33 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 depends on claim 9.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,5,7-12, 32,33,41 rejected under 35 U.S.C. 102(b) as being anticipated by Japan 10-217108.

Japan '108 discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising an annular groove disposed in the bottom of the

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retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental.

Claims 1-3,5,7-13, 32,33,41 rejected under 35 U.S.C. 102(b) as being anticipated by Japan 11-333712.

Japan '712 discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising concentric annular grooves disposed in the bottom of the retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental.

Claims 1-3,5,7-12,14, 32,33,41 rejected under 35 U.S.C. 102(e) as being anticipated by Glashauser-6,419,567.

Glashauser discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising an annular groove disposed in the bottom of the retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,5,7-12, 15-20,29-33,41 rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '108, alone.

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Japan '108 discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising an annular groove disposed in the bottom of the retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental and would have been a matter of obvious design choice. The selection of the material of the retaining ring would have been an obvious design expedient dependent on machining parameters.

Claims 1-3,5,7-13, 15-20,25,26, 29-33,41 rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '712,alone.

Japan '712 discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising concentric annular grooves disposed in the bottom of the retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental and would have been a matter of obvious design choice. The selection of the material of the retaining ring would have been an obvious design expedient dependent on machining parameters.

Claim1-3,5,7-12,14-20,27-33,41 rejected under 35 U.S.C. 103(a) as being unpatentable over Glashauser '567, alone.

Glashauser discloses a retaining ring of a subcarrier for holding a wafer during polishing comprising an annular groove disposed in the bottom of the retaining ring. The distance of the groove from the edge, and the depth and width based on magnitude of a force is incidental and would have been a matter of obvious design choice. The selection of the material of the retaining ring

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would have been an obvious design expedient dependent on machining parameters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P Morgan whose telephone number is 703.308.1743.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703.308.2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM  
August 6, 2004



EILEEN P. MORGAN  
PRIMARY EXAMINER